

REMARKS

This Amendment is being filed in response to the Office Action issued March 24, 2003. Claims 169-188 were pending in the above-identified application. By this Amendment, Applicants have amended claims 169, 174 and 184, canceled claim 175 and amended the specification to reflect the current address of the American Type Culture Collection. Accordingly, upon entry of this Amendment, claims 169-174 and 176-188 will be pending and under examination.

Support for the amendments to claim 169 may be found *inter alia* in the specification, as originally-filed, at page 27, lines 3 to 6 and in Figure 1. Such amendment involve no issue of new matter. Applicants respectfully request that this Amendment be entered.

Restriction Requirement

On page 2 of the March 24, 2003 Office Action, the Examiner acknowledged that in response to the restriction requirement, applicants have cancelled the previously pending claims and added new claims 169-188 which correspond to original Group I.

Priority

On page 2 of the March 24, 2003 Office Action, the Examiner stated that applicant's preliminary amendment A, Paper No. 1/12, filed November 28, 2001, was not entered because no marked-up version of the amendment was attached.

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Based on an August 25, 2003 telephone conference between Examiner Eileen O' Hara and Ms. Agnes Xu, a legal assistant in the undersigned attorney's office, Examiner O'Hara indicates that referring to page 2 of the March 24, 2003 Office Action, applicant's preliminary amendment A, Paper No. 1/12, filed November 28, 2001 should read June 20, 2001 and not November 28, 2001.

In response to the Examiner's request, applicants have amended the specification above on page 1 to correct and update the priority information with respect to applicant's preliminary amendment A., Paper No. 1/12, filed June 20, 2001.

Claim Objections

On page 3 of the March 24, 2003 Office Action the Examiner objected to claims 184 and 185 as being in improper dependent form for failing to further limit the subject matter of a previous claim.

In response, in an attempt to advance the prosecution but without conceding the correctness of the Examiner's position, Applicants have amended claim 184 to depend from claim 181.

Applicants maintain that the subject matter of amended claim 184 is described in the specification as originally-filed and respectfully request that this objection be withdrawn.

On page 3 of the March 24, 2003 Office Action, the Examiner objected to claim 169 and stated that the full name of the protein, melanin concentrating hormone 1, should be spelled out in the independent claims.

In response, in an attempt to advance the prosecution but without conceding the correctness of the Examiner's position, Applicants have amended claim 169 to recite the full name of the protein.

Accordingly, applicants respectfully request that these grounds of objection be withdrawn.

35 U.S.C. § 112 Rejections

On page 3 of the March 24, 2003 Office Action, the Examiner alleged that claims 173 and 180 contain subject matter which was not described in the specification in such a way to enable one skilled in the art to which it pertains to make and/or use the invention. The Examiner requested that applicants file an affidavit or declaration stating or a statement by an attorney at record that deposits have been accepted by an International Depository Authority under the provisions of the Budapest Treaty.

In response, applicants' undersigned attorney states that in accordance with 37 C.F.R. §1.808(a)(2) all restrictions imposed by the depositor on the availability to the public of the

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deposited materials will be irrevocably removed upon the granting of a patent from the subject application. Applicants attach hereto as **Exhibit A** a copy of the ATCC Budapest Treaty Deposit Receipt for plasmid pcEXJ.HR-TL231 (ATCC Accession No. 203197) indicating that the deposit was made under the terms of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purpose of Patent Procedure on September 17, 1998.

Accordingly, applicants maintain that claims 173 and 180 comply with the requirements of 35 U.S.C. §112, first paragraph, and respectfully request that the Examiner reconsider and withdraw this ground of rejection.

On page 4 of the March 24, 2003 Office Action, the Examiner requested that Applicants amend the specification to recite the complete name and address of the depository.

In response, applicants have amended the specification above on page 37 to reflect the current address of the American Type Culture Collection.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

35 U.S.C. § 102 Rejections

On page 5 of the March 24, 2003 Office Action, the Examiner rejected claims 169-172, 175-179, and 181-188 under 35 U.S.C.

§ 102(e) as anticipated by Bergsma, et al., U.S. Patent No. 6,033,872, dated December 11, 1996. The Examiner alleged that Bergsma, et al., discloses a nucleic acid (SEQ ID NO: 1) encoding a protein (SEQ ID NO: 2) identified as 11cb splice variant that is 100% identical to amino acids 70-422 of SEQ ID NO: 2 of the instant application and 100% identical to the protein of SEQ ID NO: 28 of the instant application. The Examiner alleged that the protein of Bergsma, et al. meets the limitation of an analog or mutant of SEQ ID NO: 2 of the instant application and that Bergsma, et al. also teach that the nucleic acid can be DNA, cDNA or RNA, vectors such as baculovirus and plasmids in which the nucleic acid is operatively linked, host cells such as yeast, COS, insect Sf9 cells, Xenopus oocytes and membrane preparations from the cells.

In response, in an attempt to advance the prosecution but without conceding the correctness of the Examiner's position, Applicants have amended claims 169 and 174 and cancelled claim 175 without disclaimer or prejudice. As a result, claims 169 and 174 no longer recite "analog" or "mutant."

Additionally, applicants respectfully point out that Bergsma, et al. did not disclose that MCH is the ligand for the receptor disclosed by them.

Accordingly, applicants respectfully request that this ground of rejection be withdrawn.

On page 6 of the March 24, 2003 Office Action, the Examiner rejected claims 169-172, 175-179 and 181-188 under 35 U.S.C. § 102(a) as anticipated by Bergsma, et al., U.S. Patent No. 6,033,872, dated December 11, 1996. The Examiner alleged that Bergsma, et al., discloses a nucleic acid encoding a protein identified as 11cb splice variant that is 100% identical to amino acids 70-422 of SEQ ID NO: 2 of the instant application and 100% identical to the protein of SEQ ID NO: 28 of the instant application. The Examiner further stated that Bergsma, et al., also teach that the nucleic acid can be DNA, cDNA or RNA, vectors such as baculovirus and plasmids in which the nucleic acid is operatively linked, host cells such as yeast, COS, insect Sf9 cells, Xenopus oocytes and membrane preparation from the cells.

In response, in an attempt to advance the prosecution but without conceding the Examiner's position, applicants have amended claims 169 and 174 and cancelled claim 175 without disclaimer or prejudice. Thus, claims 169 through 188 no longer encompass a nucleic acid encoding a protein that is 100% identical to SEQ ID NO: 1 of Bergsma, et al.

Accordingly, applicants respectfully request that this ground of rejection be withdrawn.

Allowable Claims

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On page 7 of the March 24, 2003 Office Action, the Examiner acknowledged that claims 173 and 174 would be allowable if rewritten in independent form including all of the limitations of the base and intervening claims.

Applicants thank the Examiner for this indication of allowability for claims 173 and 174. Applicants maintain that the amendments made hereinabove render all the claims now pending allowable, namely, claims 169-174 and 176-188.

Information Disclosure Statement

On page 2 of the Office Action the Examiner indicated that the second supplemental information disclosure statement filed September 23, 2002 (paper No. 12) is in the file but that the PTO-1449 form and copies of the references are missing. The Examiner therefore requested that applicants submit a copy of the references for consideration.

In response, applicants submit as **Exhibit 1** hereto a copy of the previously filed PTO-1449 form and as **Exhibits 2 to 10** copies of the references previously submitted. Applicants request that these references be considered and made of record.

In addition, applicants submit herewith as **Exhibit 11** a further PTO-1449 form listing the following three (3) related copending U.S. applications:

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1. U.S. Serial No. 09/899,732, filed July 5, 2001 (**Exhibit 12**);
2. U.S. Serial No. 10/029,314, filed December 20, 2001 (**Exhibit 13**); and
3. U.S. Serial No. 10/341,751, filed July 14, 2003 (**Exhibit 14**).

Copies of these applications are enclosed as **Exhibits 12 to 14**. Applicants request that these applications be considered and made of record.

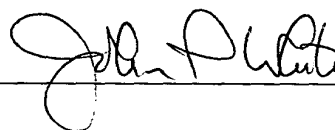
In summary, in light of the remarks made hereinabove, applicants respectfully request that the Examiner withdraw all of the grounds of objection and rejection set forth in the March 24, 2003 Office Action and issue a notice of allowability for the claims.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.


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No fee, other than the enclosed fee of \$410.00, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
	8/25/03
John P. White Reg. No. 28,678	Date